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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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KATAKAM, SUDHAKAR

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1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

3  
4  
5 BEFORE THE BOARD OF PATENT APPEALS  
6 AND INTERFERENCES  
7

8  
9 Ex parte ANDREAS WOLFERT, CHRISTIAN MULLER,  
10 ECKHARD STROFER, MARKUS WEBER,  
11 JOACHIM PFEFFINGER, and CARSTEN KNOSCHE  
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14 Appeal 2009-008651  
15 Application 10/523,919  
16 Technology Center 1600  
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19 Oral Hearing Held: April 14, 1600  
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22  
23 Before TONI R. SCHEINER, RICHARD M. LEBOVITZ, and  
24 FRANCISCO C. PRATS, Administrative Patent Judges.  
25

26  
27 ON BEHALF OF THE APPELLANT:  
28

29  
30 HARRIS A. PITLICK, ESQUIRE  
31 Oblon Spivak McClelland Maier & Neustadt, LLP  
32 1940 Duke Street  
33 Alexandria, Virginia 22314  
34 (703) 413-3000

1           The above-entitled matter came on for hearing on Wednesday,  
2 April 14, 2010, commencing at 9:34 a.m., at the U.S. Patent and Trademark  
3 Office, 600 Dulany Street, Alexandria, Virginia, before Ashorethea  
4 Cleveland, Notary Public.

5           JUDGE SCHEINER: We're ready whenever you are.

6           MR. PITLICK: Okay. In this case, the issue is whether claims  
7 one through six are unpatentable under 35 USC Section 103 over a reference  
8 to Ohlinger, et al.

9           The claim subject matter is a process for preparing aromatic  
10 diisocyanate and I want to emphasize the aromatic by reacting phosgene  
11 with a diamine which necessarily has to be aromatic in order to get aromatic  
12 diisocyanate, and it's got to be carried out in a particular temperature range  
13 and a particular pressure range.

14           Now, Ohlinger, et al makes such diisocyanates but from a liquid  
15 phase; and as we pointed out, it's certainly not unusual to make aliphatic and  
16 aromatic diisocyanates from the liquid phase. However, it has been  
17 problematical to make aromatic diisocyanates from the gas phase.

18           As a matter of fact, we even mention in the specification that  
19 certainly we're not the first to use the gas phase to make these things; but  
20 you know, the prior art, other prior art which has not been applied here, had  
21 problems.

22           JUDGE LEBOVITZ: Well, that's kind of a question. The spec  
23 on the first page describes three patent complications, WO's. Does the  
24 Examiner cite them or were they ever cited during prosecution? It always  
25 concerns us that 103 is in the context of a scope and the content of a prior

1 art, and if it's admitted in the spec it's prior art but we don't really see a  
2 discussion of the prior art other than what's in the spec.

3 MR. PITLICK: Of course. Unfortunately, I don't have the  
4 entire file with me. It's generally our practice certainly in a case like this that  
5 we would have cited these references in an IDS. I can't say for sure right  
6 now whether we did.

7 Again, I can go back and file a supplemental paper if you'd like;  
8 but they certainly have never been applied in a rejection, as far as I can  
9 recall. I think the rejection again -- I'm basing this on memory because in  
10 preparation for this oral hearing, I'd simply just gone over the Briefs, the  
11 reference, et cetera. I didn't go over the entire prosecution history.

12 My recollection is that this Ohlinger reference has been used  
13 from the get-go.

14 So, again, it's not simply a matter, as the Examiner seems to  
15 say, well, you have a liquid and so what? It's been done in the gas phase  
16 before although the Examiner was relying on statements that we had made;  
17 and we said, yeah. Generally it's okay to go from the gas phase when you're  
18 dealing with aliphatic diisocyanates. But again, when you're making  
19 aromatic diisocyanates, you have problems. And by and large, you know,  
20 it's the pressure range more than anything else that appears to be significant  
21 here.

22 It's really not much more I can say as far as the actual rejection  
23 before you. It's obviously not simply a matter of going from a liquid to a gas  
24 because, as I say, there are other variables here, especially that pressure  
25 limitation.

1 JUDGE LEBOVITZ: But the Ohlinger reference says, at least  
2 in column one, that you can carry out the reaction in gas phase. I think that's  
3 said elsewhere in the reference, as well; and then when you go to column  
4 four of the reference, they disclose temperatures and pressures for carrying  
5 out their reaction which overlap those which are claimed.

6 So, given the fact that the reference says liquid or gas, the  
7 pressures and temperatures overlap with those that are claimed, why  
8 shouldn't we consider that prima facie obvious to do it in gas following those  
9 directions?

10 MR. PITLICK: Because you can't equate temperatures and  
11 certainly pressures when you have gas versus liquid. I mean, it's like  
12 comparing apples to shoes. You know, it's an entire, different phase. I think  
13 you could throw out certainly the pressure overlapping totally.

14 Certainly, I'm not an expert chemist or physical chemist but I  
15 don't know anywhere -- I don't know where there's any suggestion that you  
16 can ignore the fact that one is a gas and one is a liquid when you have  
17 overlapping pressures. I don't think anyone would consider them to be  
18 equivalent even if they were the same.

19 JUDGE LEBOVITZ: Do you recall if the Examiner gave a  
20 reason for why given one would use those operating parameters which are  
21 disclosed for a liquid in a reaction that's performed in a gas phase?

22 MR. PITLICK: Again, I'm speaking from recollection. The  
23 Examiner may have adopted your rationale or may have simply said it's just  
24 obvious to optimize these parameters. It probably would have been one or  
25 the other. I suspect it's in the Examiner's Answer. Yeah. I'm looking at the  
26 last paragraph on page three of the Examiner's Answer: "It would be prima

1 facie obvious with one skilled in the art," et cetera, "to determine the  
2 temperature and reaction during the concentration with the phosgene and the  
3 phosgene hold-up in the optimization process." "One would be motivated to  
4 optimize these limitations as reasonable expectations may also be increased,"  
5 et cetera, et cetera.

6 The Examiner mentions the fact that Ohlinger discloses a  
7 pressure of five to 100 bar, temperature of 100 to 220; and as you indicate,  
8 there's overlap. I must say, we're a lot narrower than five to a hundred.

9 But again, I don't think you can compare gas versus liquid in  
10 this context.

11 JUDGE LEBOVITZ: And one thing. I think the Examiner  
12 may have improperly interpreted the claim to not require both the reactants  
13 to be in gas phase.

14 MR. PITLICK: That's right; and we pointed that out because  
15 we respond in the specification what we mean by that. We pointed that out  
16 in the Reply Brief, I believe. One of the Briefs. I think it was the Reply  
17 Brief.

18 JUDGE PRATS: It was the Reply Brief, I'm sure.

19 MR. PITLICK: Yeah. What we mean by that. Yeah. It means  
20 everything is carried out in the gas phase.

21 So, if there are no more questions.

22 JUDGE SCHEINER: We have no more questions.

23 MR. PITLICK: Thank you.

24 JUDGE PRATS: Thank you.

25 Whereupon, at approximately 9:43 a.m., the proceedings were  
26 concluded.